

Remarks

Claims 1, 4-17, 24, 26-29 and 31 are pending. Claims 2, 3, 18-23, 25 and 30 are canceled in this Response.

Allen Does Not Preclude Patentability Under Section 103.

Claims 9, 10, 12, 13, 15-17, 28 and 31 stand rejected under Section 103 as being obvious over Allen 20040012644 or Allen combined with other references. Allen can qualify as prior art only under Section 102(e). Hewlett-Packard Development Company (or its predecessor in interest Hewlett-Packard Company) owned Allen and the present Application at the time of the invention, as is evident from the assignments of Allen recorded November 26, 2002 (inventors to Hewlett-Packard Co.), June 18, 2003 (Hewlett-Packard Co. to Hewlett-Packard Development Company) and September 30, 2003 (Hewlett-Packard Co. to Hewlett-Packard Development Company) at reel/frame 013529/0641, 013776/0928 and 014061/0492, respectively, and the assignment of this Application recorded March 8, 2004 (inventors to Hewlett-Packard Development Co.) at reel/frame 014405/0816. Pursuant to Section 103(c), therefore, Allen does not preclude the patentability of Claims 9, 10, 12, 13, 15-17, 28 and 31.

Rejections Under Section 102

Claims 1, 4-8, 11, 14, 26, 27 and 29 were rejected under Section 102 as being anticipated by Allen.

Claim 1 has been amended to incorporate the limitations of Claim 2 and/or Claim 3. Accordingly, Claims 2 and 3 have been canceled. Claim 1 now recites determining an amortized cost related to the printing device per sheet of media and/or related to an operation of the printing device; and calculating the cost of printing to the media by adding a cost of the sheet of media actually used and a cost of the pigment used on the sheet of media and an amortized cost related to the printing device per sheet of media and/or related to an operation of the printing device. Claims 2 and 3 were rejected under Section 103 as being obvious over Allen in view of Joel. As noted above, under Section 103(c) Allen does not preclude the patentability of Claims 2 and 3 and, accordingly, cannot preclude the patentability of amended Claim 1.

Claim 5 recites identifying an entity to which the costs will be allocated and allocating the cost of the media actually used and the cost of the pigment used to the

entity. The Examiner asserts that (1) identifying an entity to which costs will be allocated is "inherent with [0061] where it shows that the printer is typically connected to a personal computer, and a user must identify him/herself through use of a user id/password to log on to a personal computer in order to use the printing system...." and (2) allocating the cost to the entity is taught in Allen paragraph [0050] "printer cost and usage reported via web server, display, etc." Neither assertion is correct.

Claim 5 recites the act of identifying an entity to which the costs will be allocated and then allocating those costs to the entity. Allen does not teach any such acts. The fact that a printer may be connected to a personal computer and/or that a user has to identify herself to the system is wholly irrelevant to the act of identifying an entity to which printing costs will be allocated unless, of course, the user is identified as that entity. One might **speculate** that Allen's user is an entity to which printing costs are allocated, but speculation has no part in establishing a prima facie case of anticipation. The plain fact is that there is nothing in Allen that even remotely suggests the user is an entity to which printing costs are or should be allocated in general, and specifically Allen does not teach or suggest the act of identifying the user as an entity to which printing costs will be allocated. If the Examiner disagrees, then the Examiner is respectfully requested to point out and specifically explain those passages in Allen that might somehow reasonably be interpreted as teaching the claimed act of identifying (bearing in my mind the test for inherency¹).

Allen also does not teach the act of allocating the printing costs to the entity identified in the earlier act of identifying. The fact that Allen may teach "printer cost and usage reported via web server, display, etc.", as asserted by the Examiner, does not in the least imply or suggest allocating printing costs in general, and specifically not allocating those costs to an entity identified in an earlier act of identifying. Again, if the Examiner disagrees, then the Examiner is respectfully requested to specifically explain

¹ To establish inherency, the Examiner must show that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP § 2112, paragraph IV (emphasis added).

how simply reporting or displaying costs constitutes allocating those costs to a specifically identified entity.

Claim 5 distinguishes patentably over Allen under Section 102.

Claim 26 has been amended to incorporate the limitations of Claim 30. Accordingly, Claim 30 has been canceled. Claim 26 now recites that allocating the cost of the print job to an entity includes storing a billing code in the data storage system associated with the entity, the data processing system reading a billing code associated with the print job and allocating the cost of the print job to the entity associated with the billing code. Claim 30 was rejected under Section 103 as being obvious over Allen in view of Lacheze. As noted above, under Section 103(c) Allen does not preclude the patentability of Claim 30 and, accordingly, cannot preclude the patentability of amended Claim 26.

All pending claims are in condition for allowance.

The foregoing is felt to be a complete response to the pending Office Action.

Respectfully submitted,

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